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- II. Claims 1-24 and 32-34, drawn to a compound of formula 1B, and compositions thereof;
- III. Claims 25-31, drawn to a method of cleaving a target mRNA in a subject or host cell comprising administering the compound of formula 1A to said subject or host cell; and
- IV. Claims 25-31, drawn to a method of cleaving a target mRNA in a subject or host cell comprising administering the compound of formula 1B to said subject or host cell.

The Examiner alleged that the inventions are distinct, each from the other, because they are related as product and process of use. The Examiner stated that the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that, referring to M.P.E.P. §806.05(h). In the instant case the Examiner alleged that the nucleic acid molecules of groups I-II are directed to products, and groups III-IV correspond to methods of using the nucleic acid molecules of groups I-II. The Examiner also alleged that the invention of groups I-II may also be used in methods other than those described in the invention of groups III-IV. For example, the claimed nucleic acid molecules may be used as an endonuclease in a cell free system to cleave a target mRNA molecule.

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The Examiner also alleged that the inventions of groups I-II are distinct since they are directed to patentably distinct nucleic acid molecules possessing different nucleotide sequence compositions.

The Examiner also alleged that inventions of groups III-IV are directed to the patentably distinct methods comprising the use of distinct nucleic acid molecules.

On the assertion that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the Examiner alleged that restriction for examination purposes as indicated is proper.

The Examiner also alleged that these inventions are distinct for the reason that a search required for Group I is not required for Group II, and the search for Group III is not required for the search of Group IV.

In response, applicants hereby elect, with traverse, Group I, claims 1-24 and 32-34 drawn to a compound of formula 1A.

Initially, applicants point out that all of the process of use claims of Group III, as identified by the Examiner, depend on and incorporate the limitations of product claim 1 of elected Group I. While applicants note the Examiner's reliance on M.P.E.P. § 806.05(h) to restrict the product from the use, applicants respectfully point out that the relied upon section does not address how to treat such claims once the product claim is allowed. M.P.E.P. § 806.05(i) addresses how to treat

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such claims once the product claim is allowed:

Where the product claims are allowable (i.e., novel and nonobvious), restriction may be required only where the process of making and the product made are distinct (MPEP § 806.05(f)); otherwise, *the process of using must be joined with the process of making and product made, even if a showing of distinctness can be made between the product and process of using* (MPEP § 806.05(h)). (Emphasis added)

Indeed, such treatment of the claims is rational in view of the minimal burden on the Examiner to examine process of use claims which incorporate all of the limitations of allowed product claims. While applicants contend that the restriction between Groups I and III is not proper for reasons which follow, applicants hereby respectfully request that the Examiner examine the use claims of Group III once the product claims of Group I are found allowable.

Similar treatment is also appropriate of the claims of Groups II and IV.

Regarding the restriction between Groups I and II, applicants respectfully point out that claim 1 is a linking claim that links the inventions of Groups I and II. Pursuant to M.P.E.P. §§ 809, 809.03 and 809.04, claim 1 should be examined in its entirety, i.e. for both structures 1A and 1B, once applicants' elected invention is found allowable. Specifically, pursuant to M.P.E.P. § 809.04 "[I]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim

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is generic thereto, or he or she must examine *the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.*" While applicants contend that the restriction between Groups I and II is not proper for reasons which follow, applicants hereby respectfully request that the Examiner examine the nonelected invention of Group II once the invention of Group I is found allowable.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement in its entirety. Under 35 U.S.C. § 121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. § 803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of Groups I, II, III and IV are not independent. Under M.P.E.P. § 802.01, "independent" means there is no disclosed relationship between the subjects disclosed. The inventions of Groups I and II are drawn to related compounds and the invention of Groups III and IV are drawn to a use of the compounds. Applicants therefore maintain that the Groups are not independent and restriction is not proper.

Furthermore, under M.P.E.P. § 803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there

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are two criteria for a proper requirement for restriction: 1) the invention must be independent and distinct, **and** 2) there must be a serious burden on the Examiner if restriction is not required.

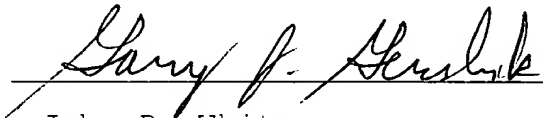
Applicant respectfully submit that there would not be a serious burden on the Examiner if restriction is not required, because the classification of Groups I and II, and III and IV, respectively, even according to the Examiner, are in the same classes. Thus, a search of the prior art relevant to Group I would necessarily turn up the prior art relevant to the claims of Group II, and vice versa. Moreover, any such search would certainly uncover uses of the compounds of Group I and II. Since there is no burden on the Examiner to examine Groups I-IV together in the subject application, the Examiner must examine the entire application on the merits.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. § 121 and respectfully requests that the Examiner reconsider and withdraw the requirement for restriction. At the minimum, applicants respectfully request that Group III should be examined with elected Group I in the subject application.

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No fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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